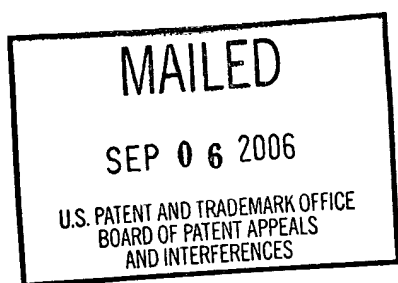


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte RUSSELL D. WILFERT

Appeal No. 2006-1784
Application No. 10/668,819

ON BRIEF

Before OWENS, CRAWFORD, and LEVY, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 20, which are all of the claims pending in this application.

The appellant's invention relates to a plug valve that includes a segment seal (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Stark	2,391,278	Dec. 18, 1945
Melichar	2,506,097	May 2, 1950
Brown	3,479,006	Nov. 12, 1964

THE REJECTIONS

Claims 1, 2, 4 to 12, 14 to 17, 19 and 20 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

Claims 1 to 3, and 5 to 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Melichar.

Claims 4 and 17 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Melichar in view of Brown.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed November 1, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed September 20, 2005) and reply brief (filed December 28, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection under 35 U.S.C. § 112, first paragraph. We initially note that it is well settled that the examiner bears the initial burden of providing reasons why a supporting disclosure does not enable a claim.

In re Marzocchi, 439 F. 2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). It has long been held that "[t]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" Genentech, Inc. v. Novo Nordisk, A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting from In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Further, in In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) the court stated that factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in Ex parte Forman [230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986)]. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples,

(4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement¹ against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

¹ The appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art knew at the time of filing the application.

The examiner is of the opinion that :

. . . appellant's claims recite a "closed position" of the valve, where there is no fluid communication between the valve plug flow passage, and the inlet and outlet ports of the valve body. Here, a "closed position" appears to be contradicted by the geometry of the claimed invention taken with the description thereof in the specification [answer at page 6].

In essence, it is the examiner's view that there is fluid communication with the valve body outlet and the plug flow passage in the closed position depicted in Figure 2.

Firstly, we agree with the appellant that claim 1 does not require that the plug fluid passage is not in fluid communication with the valve body fluid outlet but rather that there is no fluid communication with the outlet *and* the inlet of the valve body. There is clearly no fluid communication between the plug body and the valve body inlet in Figure 2.

In any case, the examiner has not met his burden as he has failed to discuss any of the above-listed Wands factors. This is so even though the examiner has directed our attention to the Stark reference because the examiner has not addressed the Stark reference in regard to the issue of undue experimentation. As such, the examiner has failed to establish that undue experimentation would have been required to make and use the invention.

The rejection is not sustained.

We turn next to the examiner's rejection of claims 1 to 3 and 5 to 16 under

35 U.S.C. § 103 as being unpatentable over Melichar. The examiner's findings in regard to this rejection can be found on pages 4 to 5 of the answer. The examiner recognizes that Melichar does not describe a sealed vent region having a cross sectional area that is less than the defined cross sectional flow area as is required by claim 1. Nonetheless, the examiner concludes:

To reduce the cross-sectional area of the vent region would have been obvious in order to enable use of a stronger spring [answer at page 5].

We agree with the appellants that there is no motivation to modify the Melichar as contemplated by the examiner. Melichar does not teach that a stronger spring is desirable. In fact, Melichar teaches that it is desirable to use a spring that has a lower bias force (col. 4, lines 20 to 25). It is our view that the examiner's position in this appeal represents a clear case of impermissible hindsight reconstruction of the claimed invention based on appellant's own teachings.

In view of the foregoing, we will not sustain this rejection.

The decision of the examiner is reversed.

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

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STUART S. LEVY
Administrative Patent Judge